

AMENDMENT UNDER 37 C.F.R. § 1.111
US APPLICATION NO. 09/939,691
ATTORNEY DOCKET NO. Q65842

REMARKS

Applicants request that the Patent Office acknowledge Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 00402379.2 dated August 29, 2000, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on August 28, 2001, thereby confirming that the listed references have been considered.

Claims 1-11 have been examined on their merits.

Applicants herein cancel claims 8-10 without prejudice and/or disclaimer.

Applicants herein add new claims 12-17. The new claims 12-17 are supported by the original claims and the specification, and do not add any new matter. Entry and consideration of the new claims 12-17 is respectfully requested.

Claims 1-7 and 11-17 are all the claims presently pending in the application.

1. The Patent Office objects to the Title of the Invention. Applicants herein amend the Title of the Invention, and submit that the Patent Office's objection has been overcome.

2. The Patent Office objects to the arrangement of the specification. Applicants have already amended the Specification as suggested by the Patent Office in the Preliminary Amendment filed on August 28, 2001. The amendments in the Preliminary Amendment have

been incorporated into the Substitute Specification being filed concurrently with this Amendment.

3. The Patent Office objects to claims 4-10 under 37 C.F.R. § 1.75(c) as being of improper dependent form. Applicants submit that these claims were in proper form under 37 C.F.R. § 1.75(c) based on the Preliminary Amendment filed on August 28, 2001. Applicants submit that the Patent Office's objection is moot, and should be withdrawn.

4. Claim 2 stands rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. Applicant herein amends claim 2 to correct the format of claim 2. Thus, Applicants submit that the § 112 (2nd para.) rejection of claim 2 have been overcome, and request withdrawal of same.

5. Claims 8-10 stand rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. Applicants herein cancel claims 8-10 without prejudice and/or disclaimer. Applicants submit that the § 112 (2nd para.) rejection of claims 8-10 is now moot, and request withdrawal of same.

6. Claims 8 and 9 stand rejected under 35 U.S.C. § 112 (6th para.) as allegedly being improper. Applicants herein cancel claims 8 and 9 without prejudice and/or disclaimer. Applicants submit that the § 112 (6th para.) rejection of claims 8 and 9 is now moot, and request withdrawal of same.

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7. Claims 1-3, 6, 7 and 11 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ofek (U.S. Patent No. 6,259,695). Applicants traverse the rejection of claims 1-3, 6, 7 and 11, and insofar as the rejection might apply to new claims 12-17, for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

The Patent Office acknowledges that Ofek fails to teach or suggest a translation means that translates a fixed IP address of a terminating IP host into a dynamic IP address, and providing the dynamic IP address to the originating IP host to facilitate communication. Based on the Patent Office's admission, Ofek cannot possibly anticipate amended independent claims 1 and 11, which recite the translation of a fixed IP address into a dynamic IP address.

Therefore, under *Hybritech* and *Richardson*, Applicants submit that claims 1 and 11 are allowable, and further submit that claims 2, 3, 6 and 7 are allowable as well, at least by virtue of

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ATTORNEY DOCKET NO. Q65842

their dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1-3, 6, 7 and 11.

With respect to new independent claim 12, Applicants submit that claim 12 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Applicants submit that claim 12 is allowable, and further submit that claims 13-17 are allowable as well, at least by virtue of their dependency from claim 12.

8. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek in view of Mayes *et al.* (U.S. Patent No. 5,793,763). The rejection of claim 5 is now moot due to its cancellation. Applicants traverse the rejection of claim 4, and insofar as the rejection might apply to new claims 12-17, for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d

1016, 1022-23 (Fed. Cir. 1991).

- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

As noted above, the Patent Office has acknowledged that Ofek fails to teach or suggest a translation means that translates a fixed IP address of a terminating IP host into a dynamic IP

address, and providing the dynamic IP address to the originating IP host to facilitate communication. The Patent Office alleges that Mayes *et al.* provides the necessary disclosure to overcome the acknowledged deficiencies of Ofek.

The combination of Ofek and Mayes *et al.* fails to teach or suggest at least first and second translation means for translating fixed IP addresses of Real Time Data over IP hosts into dynamic IP addresses to conceal the fixed IP addresses, and exchanging the dynamic IP addresses, recited in claim 1 and included in claim 4. At best, the combination of Ofek and Mayes *et al.* discloses the conversion of a fixed IP address into a dynamic IP address in one direction only. *See, e.g.*, Figure 2 and col. 4, line 55 to col. 5, line 29 of Mayes *et al.* There is no disclosure in the combination of Ofek and Mayes *et al.* of the conversion and exchange of dynamic IP addresses between two IP hosts. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaack*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Although the Patent Office provides a bare motivation analysis with respect to adaptive security algorithms, both Ofek and Mayes *et al.* lack any teaching or suggestion about the desirability of translating the fixed IP addresses of two IP hosts into dynamic IP addresses, and then exchanging the dynamic IP addresses. Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

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Based on the foregoing reasons, Applicants submit that the combination of Ofek and Mayes *et al.* fails to disclose all of the claimed elements as arranged in claim 1, and included via dependency in claim 4. Thus, Applicants submit that claim 4 is allowable, and request that the Patent Office withdraw the § 103(a) rejection of claim 4.

With respect to new independent claim 12, Applicants submit that claim 12 is allowable for at least reasons analogous to those discussed above with respect to claim 4. Applicants submit that claim 12 is allowable, and further submit that claims 13-17 are allowable as well, at least by virtue of their dependency from claim 12..


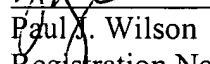
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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